

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-5, 9-26, and 30-38 are pending in the present application, and Claims 1, 16, 32-35 and 38 are amended. Support for the amendments to claims 1, 16, 32-35, and 38 is found in the specification, and no new matter is added.

In the outstanding Office Action, Claims 1-5, 9-24, and 30-35 were rejected under 35 U.S.C. §103(a) as unpatentable over Grewal et al. (U.S. Patent No. 6,691,159, hereinafter Grewal) in view of Meyer et al. (U.S. Patent No. 6,601,190, hereinafter Meyer), and further in view of Rangan (U.S. Patent No. 6,412,073); Claims 25, 26, 36, and 37 were rejected under 35 U.S.C. §103(a) as unpatentable over Grewal in view of Meyer and Rangan, and further in view of House et al. (U.S. Patent No. 6,119,247, hereinafter House); and Claim 38 was rejected under 35 U.S.C. §103(a) as unpatentable over Grewal in view of Meyer and Rangan, and further in view of Hayward et al. (U.S. Patent No. 6,629,134, hereinafter Hayward).

Applicants thank the Examiner for the courtesy of an interview extended to Applicants' representatives on April 5, 2006. During the interview, differences between the present invention and the applied art, and the rejections noted in the outstanding Office Action were discussed. No agreement was reached pending the Examiner's further review when a response is filed. Arguments presented during the interview are reiterated below.

A non-limiting embodiment of the claimed invention is directed toward providing online support to a user. To provide a user with support, a two part form is used that asks the user to input information. In addition to this, a browsing record is transmitted along with the form to a support center. In the non-limiting embodiment of the claimed invention, the browsing record allows for an estimation of the operations that the user has tried, (i.e.,

identification of the user support web pages that the user has looked at). This enables the analysis of the problem and the examination of the effective operation to be carried out more appropriately and more efficiently. When the browsing record information is stored in the user's device, the browsing record information may be added automatically or in response to a user's operation to the E mail sending the information with regard to the problem.¹

As shown in FIG. 6, in the arrangement of the non-limiting embodiment, the user's browsing record of the support information is accumulated as support log information 122. The support log information 122 stores the URLs of the Web pages browsed by the user in a time series. In the structure of the non-limiting embodiment, the support log information 122 is stored in the user's computer PC. As shown in FIG. 6, the support log information 122 is shown by the broken line, for the purpose of discrimination from the information stored in the server SV. The input window 104 and the support information 110 shown in FIG. 6 correspond to the process of self support (steps S14 and S16) shown in the flowchart of FIG. 2. The support log information 122 may be stored together with the information for specifying the user who gained the access, for example, the IP address and MAC address of the user, in the server SV or the support center's computer PCs.²

With respect to the rejections based on art, Applicants respectfully traverse the outstanding grounds of rejection because the outstanding Office Action fails to provide a *prima facie* case of obviousness for independent Claims 1, 16, 32, 33, 34, 35, and 38.

To establish a *prima facie* case of obviousness, M.P.E.P. §2143 requires that three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all

¹ Specification, paragraph 16.

² Specification, paragraph 53.

the claim elements. The outstanding Office Action is deficient with respect to the first and third requirements.

With respect to the rejection of Claim 1, Applicants respectfully traverse the rejections. Claim 1 recites, *inter alia*, “wherein the specific form comprises a first part that asks the user to input first information generally required for analysis of the problem, and a second part that enables the user to input arbitrary information with regard to the problem.” Grewal, Meyer, and Rangan do not disclose or suggest these elements of Claim 1.

Grewal discloses a technique related to a portal site that provides online support. Specifically, Grewal provides users with a portal site that enables problem solving through chatting (i.e., a chat room).³ The outstanding Office Action appears to take the position that textual dialog box 212 in Fig. 5 of Grewal equates to the claimed “specific form.” Textual dialog box merely displays one box that displays a textual interchange between an expert and the user. Textual dialog box 212 does not include “a first part that asks the user to input first information generally required for analysis of the problem, and a second part that enables the user to input arbitrary information with regard to the problem.” Furthermore, the web page of Fig. 4 is not part of textual dialog box 212, and is not a second part to box 212.

Furthermore, Grewal disclose that “filling out forms identifying a problem” is “cumbersome, impersonal, and time consuming.”⁴ Thus, Grewal establishes a distinction between a “form” and the textual dialog box 212.

Meyer and Rangan do not cure the above-noted deficiency in Grewal. The form disclosed in Meyer does not disclose or suggest the claimed two-part form. Meyer only discloses sending an email in a form to obtain user support with one field.⁵ Rangan is not

³ Grewal, Fig. 6.

⁴ Grewal, col. 1, lines 22-29.

⁵ Meyer, Fig. 2.

directed toward obtaining user support and does not disclose or suggest a two-part form as described in Claim 1.

Moreover, Claim 1 also recites, *inter alia*, “transmitting the browsing record information and the information input into the specific form to an online support operator.” The outstanding Office Action relies on Rangan to disclose this element of Claim 1.

However, the portion of Rangan cited to in the outstanding Office Action merely discloses managing bookmarks. At col. 8, lines 41-51, Rangan describes how bookmarks may be downloaded onto the same user’s local browser or uploaded to the user’s homepage. Claim 1 clearly describes that the browsing record represents a user record of browsing support information. Rangan does not disclose or suggest that the bookmarks are a record of browsing support information.

The outstanding Office Action states “Rangan teaches the transmission of a browsing record.”⁶ However, Claim 1 requires that the browsing record be transmitted to an online support operator. The user’s own browser or own webpage is not an online support operator. Applicants note that none of the words of Claim 1 can be ignored. In re Wilson, 165 USPQ 494, 496 (CCPA 1975).

Furthermore, Applicants respectfully submit that a person of ordinary skill in the art would not combine Grewal, Meyer, and Rangan. The disclosures of Rangan, Grewal, and Meyer do not provide sufficient disclosure of a motivation for transmitting both browsing record information and the claimed specific form. The outstanding Office Action states that a person of ordinary skill in the art would combine Rangan with Grewal and Meyer because “user’s browsing records are usually stored on a user’s PC.”⁷ This is not a motivation to combine references as it only states a possibility about where browsing records could be stored. Storing browsing records on a user’s PC does not suggest the desirability as to why

⁶ Office Action, page 3.

⁷ Office Action, page 4.

downloading or uploading bookmarks of Rangan should be combined with Grewal and Meyer.

Moreover, Grewal and Meyer describe techniques for obtaining user support, while Rangan describes an interactive web portal that enables users to store web pages, user names, and passwords based on user profiles. Rangan is not related to obtaining user support, and is thus non-analogous art. It is well established that for references to be considered analogous art, they must either be from the same field of endeavor as the application or they must be reasonably pertinent to a particular problem with which the inventor is involved. See In re Clay, 23 USPQ2d, 1058, 1060 (Fed. Cir. 1988). The outstanding Office Action provides no explanation as to why Rangan's interactive web portal is reasonably pertinent to a particular problem with which the inventor is involved.

Furthermore, Applicants respectfully submit that a person of ordinary skill in the art would not be motivated to combine Grewal and Meyer. Grewal specifically discloses problem solving through use of a chat room. Meyer only discloses problem solving by sending email to obtain user support. Grewal teaches away from using a form and discloses that forms are cumbersome, impersonal, and time consuming.⁸ Furthermore, Meyer teaches away from service personnel speaking directly with customers because problems with the operation of computers are often complex.⁹

"A reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). To this end, "disclosures in the references that diverge from and teach away from the invention cannot be disregarded", Phillips Petroleum Company v. U.S. Steel Corp., 9 USPQ2d 1461 (Fed. Cir. 1989).

⁸ Grewal, col. 1, lines 22-29.

⁹ Meyer, col. 1, lines 15-22.

Accordingly, Applicants respectfully submit that a person of ordinary skill in the art would not combine Grewal and Meyer.

In effect, the outstanding rejection does little more than attempt to show that parts of the inventive combination of Claim 1 were individually known in other arts and to suggest that such a showing is all that is necessary to establish a valid case of *prima face* obviousness. The PTO reviewing court recently reviewed such a rationale and dismissed it in *In re Rouffet*, 149 F. 3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) as follows:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. [emphasis added.]

There has been no such showing of those required reasons made in the final rejection.

In view of the above-noted distinctions, Applicants respectfully submit that Claim 1 (and dependent Claims 2-5 and 9-15) patentably distinguish over Grewal, Meyer, and Rangan, taken alone or in proper combination. Applicants respectfully submit that independent Claims 16, 32, 33, 34, 35, and 38 (and dependent Claims 17-31, 36, and 37) patentably distinguish over Grewal, Meyer, and Rangan, taken alone or in proper combination, for at least the same reasons as amended Claim 1.

Application No. 09/817,203
Reply to Office Action of February 2, 2006

Consequently, in light of the above discussion, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Raymond F. Cardillo
Registration No. 40,440

I:\ATTY\JW\205114US\205114US_AM DUE 5-2-06-REVISED.DOC